

REMARKS

Claim Rejections:

Claims 20-25 and 31-51 are all of the claims pending in the present application and currently all of these claims stand rejected. Applicant also notes that claims 32-38 have been cancelled without prejudice or disclaimer.

35 U.S.C. § 103(a) Rejection - Claims 20-25 and 31-51:

Claims 20-25, 31 and 39-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,809,194 to Lovie in view of U.S. Patent No. 5,703,983 to Beasley, Jr. In view of the following discussion, Applicant respectfully disagrees.

As an initial matter, Applicant notes that the Examiner is essentially ignoring the final limitation in each of claims 20, 39 and 45. Each of these claims essentially states that the physically detectable feature is detected by an automated detection system during installation of the binder. The Examiner asserts that because the claims are directed to either a binder or a cable, this method or process limitation adds no additional claim limitation.

Although Applicant disagrees with the Examiner, and does not feel that this limitation should be ignored, Applicant has taken the path of least resistance and has amended these claims as shown in the attached Appendix. Applicant submits that the amended claim language makes it clear that the "detectable" nature of the marking is a feature of the claimed invention. The fact that the marking is to be detectable provides some physical characteristic to the marking, and further limits the claims as written. Applicant hereby requests the Examiner acknowledge and consider this aspect of the claimed invention, when reviewing the prior art.

Turning now to the rejection, the Examiner is relying on the combination of the Lovie and Beasley references to render the present invention unpatentable. Applicant notes that Lovie is directed to using markings on a cable core or outer jacket to identify "switchback" points to make cable access and splicing easier. Similarly, Beasley is directed to using markings to identify "reverse oscillating lay" points within the cable for the same purpose. However, Applicant notes that neither of the references discuss determining or monitoring the lay length of binders.

Further, the Examiner states that the markings disclosed in Beasley "would inherently be considered to be *both on and within* the flexible material, because the markings themselves would become flexible parts of the cable binder." *See* Office Action, page 3 (emphasis in original). However, with regard to claims 20, 39 and 45, Applicant completely disagrees with the Examiner's comments.

Applicant notes that both the Lovie and Beasley references explicitly teach that the markings are placed "on" the core, jacket, or binder. There is no disclosure, whatever, of placing a marking "within" the binder material. Applicant also respectfully disagrees with the Examiner's assertion that this feature is "inherent" in the disclosures of Lovie and Beasley.

The law of "inherency" requires that the feature be "necessarily present" within the disclosure. This is not the case in either Lovie or Beasley. Specifically, the fact that a marking is placed "on" a core, binder or jacket, does not "necessarily" mean that the feature is placed "within" the component. These two terms have distinct and different meanings, particularly in view of the present specification.

Applicant does acknowledge that when a reference, or references, fail to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a reference “inherently” teaches the missing element or elements of the claimed invention. See In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981). However, evidence of inherency in a reference “must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added). “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. (citing In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939))) (emphasis in original); see also Scaltech Inc. v. Retec/Tetra L.L.C., 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In fact, even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure. See Finnigan Corp. v. I.T.C., 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

Thus, in this case, the mere fact that a marking is placed “on” a cable component does not “inherently” or “necessarily” mean that the component is placed within the component. The

Examiner's application of "inherency" in this case is misplaced. Further, Applicant notes that the placing of a marking within a binder material is not obvious in view of the cited references. This is particularly true because neither of the cited references have anything to do with the determination of a binder lay length.

In view of the foregoing, Applicant submits that even if the references were combined as the Examiner has suggested, the resultant combination would fail to teach or suggest each and every feature of the present invention. Namely, having the marking within the binder material.

Therefore, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 20, 39 and 45, and hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 103(a) rejection of these claims. Further, as claims 21-25, 31, 40-44 and 46-51 depend on these claims, respectively, Applicant submits that these claims are also allowable, at least by reason of their dependence.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
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Respectfully submitted,



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